

### REMARKS

At the outset, the Examiner is thanked for the review and consideration of the pending application. The Office Action dated April 8, 2009 has been received and its contents reviewed. Reconsideration of the pending application is respectfully requested in view of the following observations.

1. Amendments and Support for Same.

By this Response, claims 2, 3, 10, 11 and 21 are hereby amended. Support for the amendments to claims 2, 3, 10, 11 and 21 can be found at least at Applicant's Figures and Specification. Support for the amendments to claims 2, 3, 10 and 11 can also be found at claim 6 as originally filed. No new matter is added. Claims 1, 4-9, 12-13, 15-17, 19-20 and 24-25 are hereby cancelled; claims 26-31 are hereby newly added, support for which is found at Applicant's Specification and Figures. No new matter is believed to be added. Accordingly, claims 2, 3, 10, 11, 14, 18, 21-23 and 26-31 are currently pending.

2. Examiner Interview.

At the outset, the Examiner and the Examiner's Supervisor are thanked for the courtesies extended during a personal interview on June 12, 2009.

The substance of the interview is found in the Examiner's PTOL-413 form.

3. Claims 2, 3, 6, 10, 11, 14, 18 and 21-23 are rejected under 35 U.S.C. §103(a) as unpatentable over United States patent 7,020,780 B1 (Mochizuki) in view of United States patent application publication 2006/0265752 A1 (Wei) and further in view of United States patent 6,973,015 B1 (Murakami).

The rejection of claims 2 and 21 as unpatentable over the combination of Mochizuki, Wei and Murakami has been considered but is most respectfully traversed.

The combination of Mochizuki, Wei and Murakami fails to teach or suggest all of the claim limitations and thus does not render the claimed invention *prima facie* obvious.

The combination fails to teach or suggest at least the claimed, "a secret code memory storing a secret code modulated in accordance with a previously determined

procedure in a range capable of recognizing positions in the radial direction of the optical disc and positions in the track direction of a plurality of marks forming the BCA code as the BCA code, with respect to the BCA code stored in said BCA code memory.”

Claim 2 has been amended to include claim 6 and the Examiner indicates “a feature in independent claim 6 was discussed, which appears to distinguish from prior arts of record.” (Interview Summary, PTOL-413 of June 12, 2009).

Accordingly, it is believed that the combination of Mochizuki, Wei and Murakami fails to teach or suggest all of the limitations of amended claim 2.

In the present invention, the secret code, which ordinarily cannot be recognized, is made to be included in the BCA code by changing positions where marks of BCA are recorded one by one within a tolerance of a BCA standard (inclusive of changing a shape including a width and a length), in addition to modulation for ordinary BCA code writing.

By contrast, in Murakami, a cipher code is written in an add-on writing area in BCA area where an original BCA code is recorded.

Further, in the present invention, the secret code is made to be included in the BCA code by changing the positions where the marks which constitute the original BCA code are recorded one by one, within the tolerance of the BCA standard (inclusive of changing a shape including a width and a length), such feature that information other than the BCA code is made to be included in the BCA code by changing the positions where marks are recorded one by one is not found in the combination of references.

Further, in rejecting claim 6, now included into claim 2, the Examiner has not provided any articulated reasoning with some rational underpinning for the modification of Mochizuki, in view of Wei and Murakami.

In view of *KSR* it is now clear that a *prima facie* case for obviousness does not require “motivation” in the form of an express teaching in the references themselves. However, *KSR* also stated that the legal conclusion of obviousness requires:

“an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.” [82

USPQ at 1396]

Further, *KSR* cited with approval, 82 USPQ at 1396, the following statement from *In re Khan*, 78 USPQ 1329 (Fed. Cir. 2006):

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

Thus, in making a rejection for obviousness, the burden remains on the Examiner to present “articulated reasoning with some rational underpinning” for the combination or modification which bridges the differences between the claimed invention and the prior art.

Accordingly, because the combination fails to teach or suggest all of the claim limitations, and further because there is no articulated reasoning with some rational underpinning for the combination or modification, the rejection of claims 2 and 21 should therefore be withdrawn.

The rejection of claims 3, 18, 22 and 23 as unpatentable over the combination of Mochizuki, Wei and Murakami has been considered but is most respectfully traversed.

Claim 3 has been amended to include claim 6 and for all of the above reasons with respect to the rejection of claims 2 and 21, the rejection of claims 3, 18, 22 and 23 should be withdrawn.

The rejection of claims 10, 14, and 21 as unpatentable over the combination of Mochizuki, Wei and Murakami has been considered but is most respectfully traversed.

Claim 10 has been amended to include claim 6 and for all of the above reasons with respect to the rejection of claims 2 and 21, the rejection of claims 10, 14, and 21 should be withdrawn.

The rejection of claims 11, 18, and 22 as unpatentable over the combination of Mochizuki, Wei and Murakami has been considered but is most respectfully traversed.

Claim 11 has been amended to include claim 6 and for all of the above reasons with respect to the rejection of claims 2 and 21, the rejection of claims 11, 18, and 22 should be withdrawn.

4. New Claims 26-31.

Claims 26-31 are newly added and include further features of the present invention. Claims 26-31 are believed patentable over the combination of references.

5. Conclusion.

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

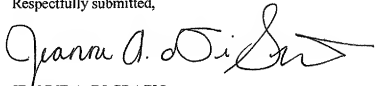
If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's attorney, the Examiner is invited to contact the undersigned at the numbers shown below.

The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment to Deposit Account Number 02-0200.

BACON & THOMAS, PLLC  
625 Slaters Lane, Fourth Floor  
Alexandria, Virginia 22314-1176  
Phone: (703) 683-0500  
Facsimile: (703) 683-1080

Date: August 10, 2009  
JDG/tms

Respectfully submitted,



JEANNE A. DI GRAZIO  
Attorney for Applicant  
Registration No. 58,633